

RESPONSE under 37 C.F.R. § 1.111
U.S. Appln. No. 10/762,674

REMARKS:

Claims 1, 4-19 and 21-22 are all the claims pending in the present application and stand rejected. Reconsideration and allowance of all pending claims are respectfully requested in view of the foregoing amendments and remarks that follow.

PREVIOUS PETITION UNDER 37 C.F.R. 1.181.

On January 17, 2006, Applicant petitioned for reconsideration of a premature final rejection. In the 4/3/06 Office Action, no mention or decision regarding Applicant's petition has been provided. Applicant respectfully requests a formal answer to the petition, which requires review by the supervisory examiner, as specified under the provisions of 37 C.F.R. 1.181.

CLAIM REJECTIONS.

35 U.S.C. § 102

Claim 11 is rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,836,212 to Sawinski. Applicant respectfully traverses this rejection for the following reasons.

Sawinski discloses a loss prevention system for reducing the likelihood of losing a portable electronic device (100, 201) that has been inadvertently removed from its retaining device (203, 300, 400). The electronic device 100 includes a proximity detector 103 that operates to detect the absence or removal of the device from its retaining device 203, 300, 400.

The 4/3/06 Office Action alleges that Sawinski's electronic unit 100 and housing 400 are analogous to that claimed by Applicant in claim 11 which recites:

- 11. A portable media device comprising:
an electronic unit; and
a housing configured to house the electronic unit, wherein at least a portion of said housing is formed as a locking retaining clip comprising a moving member having a*

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first position for attaching the media device to a separate article and a second position for locking the media device to the article.

Applicant respectfully notes that Sawinski indisputably discloses a housing 101 (as opposed to element 400 being a "housing") which supports the components of its portable electronic device 100. (Col. 2, ll. 38-41). Sawinski element 400 is in fact a "retaining device," not a housing for portable electronic device 100 as alleged in the Office Action. (Col. 6, ll. 20). On this basis alone, Applicant respectfully believes the rejection of claim 11 under 35 U.S.C. § 102 is unfounded.

Additionally, while Sawinski retaining device 400 does include a fastening mechanism 403, which is a spring loaded clip (col. 6, ll. 32-34), Applicant respectfully believes that it does not include *a moving member having a second position for locking the media device to an article* as recited in claim 11. Applicant again directs the Examiner to paragraph [0015] of its specification for proper interpretation of the term "locking." It is respectfully submitted that, while it is somewhat ambiguous in the cited reference, the type of spring biased clip 403 shown in Fig. 4 of Sawinski does not "lock" portable electronic device 100 to articles in that it would not permanently deform when the portable electronic device 100 were pulled away from an article it may be attached to. In fact, the entire premise of the Sawinski reference is dedicated to a proximity detector for addressing the potential inadvertent removal of a portable electronic device from its retaining device. (Col. 1, ll. 15-30).

Notwithstanding, in an attempt to advance the prosecution of this case, Applicant amends claim 11 to recite that the housing is configured *to house* the electronic unit. Applicant respectfully submits that Sawinski housing 101 does not include a locking retaining clip and thus cannot anticipate Applicant's claim 11. For the foregoing reasons, Applicant submits claim 11 is not anticipated by Sawinski and respectfully requests reconsideration and withdrawal of the §102 rejection based thereon.

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35 U.S.C. § 103

1.) Claims 1, 5-10 and 12-16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sawinski in view of previously cited U.S. Patent 6,934,568 to Charlier et al. (hereinafter "Charlier"). Applicant respectfully traverses these rejections for the following reasons.

It is well established that a *prima facie* obviousness is only established when three basic criteria are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (MPEP 2144).

In the instant rejection, the Office Action alleges that "Sawinski disclose [*sic* discloses] all the subject matter of the claimed invention except for..." and recites a list of seven different elements present in Applicant's claims which are admittedly not disclosed by Sawinski. The Office Action further alleges that Charlier discloses each of the eight missing elements and that it would be obvious to modify the Wang [*sic* Sawinski] device with the elements of Charlier "in order to perform the desire [*sic* desired] electronic need." (4/3/06 Office Action pg. 3-4).

Applicant respectfully submits that *prima facie* obviousness has not been established for this rejection because (i) there is no proper motivation or objective reasoning to modify Sawinski with Charlier as alleged; and (ii) even if it were proper to combine the elements of the cited references as alleged, the resultant combination of Sawinski and Charlier would still fail to teach or suggest several features of Applicant's pending claims.

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(i) THERE IS NO PROPER MOTIVATION TO COMBINE SAWINSKI AND CHARLIER IN THE MANNER PROPOSED.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex part Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

In the case at hand, the alleged motivation to modify Sawinski to be: (i) a digital video device, (ii) a digital camera, (iii) an audio device¹, (iv) an MP3 player, or to have (v) a data interface port which is a USB interface, or to have (vi) a locking retaining portion removable from the housing or (vii) as a protective cover for the data interface port is to perform the desired electronic need. (4/3/06 Office Action pg. 4). Applicant respectfully submits that not only is this alleged motivation not present in either of the cited references, but it is not an objective reason for one of ordinary skill in the art to combine the respective features of the cited references. The cited motivation for combining references essentially boils down to *because one might want to*. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, F.2d 680 (Fed. Circ. 1990). Conclusory statements of similarity or motivation, without any articulated rationale or evidentiary support, do not constitute sufficient factual finding to support a rejection under 35 U.S.C. § 103. MPEP 2144.08(III).

Applicant is unaware of any objective reason why the skilled artisan would modify the teachings of Sawinski with those of Charlier, except to provide a portable electronic device

¹ Applicant notes that column 1, ll. 15-25 of Sawinski already suggests an audio device, MP3 player in contrast to the statement on page 3 of the 4/3/06 Office Action.

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having a flip section and an extendable section as taught by Charlier, which uses a retaining device loss prevention system as disclosed by Sawinski.

For the foregoing reasons, Applicant respectfully submits that there is no proper motivation for combining the references as alleged in the Office Action and thus *prima facie* obviousness has not been established.

(ii) SAWINSKI AND CHARLIER FAIL TO TEACH OR SUGGEST THE LIMITATIONS PRESENT IN APPLICANT'S CLAIMS.

Even assuming, however, it would be proper to combine the teachings of Sawinski and Charlier (*arguendo*), Applicant respectfully submits that the resulting combination would still fail to teach or suggest, and in fact teach away from, many limitations present in Applicant's claims.

Generally, Charlier discloses a communication device (Fig. 4) which has a base housing 16, a flip housing 12 and an extendable housing 14. A separate latch and release mechanism 49 can be provided for holding or releasing the extendable housing 14 and can include small tabs and other protrusions for engaging with corresponding receiving tabs on the base housing 16. (Col. 5, ll. 42-47). The separate sides of the extendable housing 14 can be squeezed together to provide clearance for the tabs of latch mechanism 49 to release extendable housing 14 (which may be spring loaded). The objective of Charlier is to provide a radiotelephone device that can provide user interface (e.g., keyboard) protection when not in use, and to provide an expandable phone to improve ergonomic function upon a user's action, increasing a distance between the mouthpiece and earpiece of the phone when in use. (Col. 1, ll. 48-56).

Sawinski on the other hand, as mention previously, discloses a loss prevention system 200 for portable electronic devices that utilize a separate retaining device (e.g., 300, 400). (Col. 1, ll. 15-31).

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Applicant respectfully submits that Sawinski and Charlier, taken alone or in combination, fail to teach or suggest limitations in Applicant's independent claims 1 or 11 such as:

(Claim 1) *a portable housing unit integrated with and supporting the memory and data interface port, wherein at least a portion of the portable housing unit is formed as a locking retaining clip.....; or*

(Claim 11) *a housing configured to house the electronic unit wherein at least a portion of said housing unit is formed as a locking retaining clip.*

In reality, the suggested combination of Sawinski and Charlier appear to actually teach away from Applicant's claims as Sawinski is entirely dedicated to solving problems associated with portable electronic devices which have discrete retaining devices (e.g., 200, 300, 400) which are separate from the portable electronic device housing (101). And, Charlier fails to teach or suggest a device having a retaining device whatsoever. Because claims 5-10 depend from claim 1 and since claims 12-16 depend from claim from claim 11, the cited combination of references necessarily cannot teach or suggest all of the features of these claims either.

Additionally, Applicant respectfully submits that the cited combination further fails to teach or suggest the *flash memory* and *USB interface* of claims 8 and 16 or the *removable portion of the housing* of claim 9 which serves as a protective cover for the data interface port of claim 10. To this end, Applicant submits that the statement regarding Charlier's teaching of these features in page 3 of the 4/3/06 Office Action appear to be entirely unsupported.

Because Sawinski and Charlier, taken alone or in combination, fail to teach or suggest the features expressly or inherently recited in Applicant's claims 1, 5-10 and 12-16, *prima facie* obviousness has not been established and Applicant respectfully requests reconsideration and withdrawal of the §103 rejection based on Sawinski and Charlier.

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2. Claims 4, 17-19 and 21-22 are rejected under 35 U.S.C. § 103 as being unpatentable over Sawinski in view of Charlier in further view of previously cited U.S. Published Application US2001/0027151 to Siaperas. The Office Action alleges that Sawinski and Charlier disclose all of the limitations of these claims with the exception that the retaining clip is a carabineer clip and/or pivotally connected to the portable housing. The Office Action cites Siaperas to make up for these deficiencies alleging it would have been obvious to one of ordinary skill in the art to include a carabineer clip of Siaperas into the Sawinski and Charlier portable housing "in order to secure the housing." (4/3/06 Office Action pg. 4). Applicant respectfully traverses this rejection for the following reasons.

Applicant initially points out that Siaperas is believed to be non-analogous art by virtue of its field of endeavor (i.e., manual exercise equipment) being entirely different from electronic or portable media devices. Furthermore, it is believed that one of ordinary skill in the art of portable media or electronic devices would not have considered the use of carabineer clips to attached ropes on the exercise equipment of Siaperas to be reasonably pertinent for solving issues of losing or damaging expensive portable electronic devices. See, *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992). For this reason alone, it is believed that this §103 rejection is improper and should be withdrawn.

Furthermore, Applicant respectfully submits that there is no proper motivation to combine Sawinski and Charlier as noted previously above. Additionally, since Sawinski retaining devices 200, 300 and 400 already include mechanisms to "secure the housing" 101, the alleged motivation for combining Sawinski and Charlier with the non-analogous exercise equipment of Siaperas appears nothing more than a piecemeal attempt to reconstruct Applicant's claims based on the improper hindsight of Applicant's disclosure. Such hindsight is impermissible and can never establish a legal conclusion of *prima facie* obviousness under 35 U.S.C. § 103.

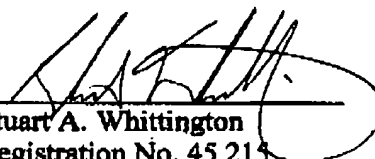
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Lastly, since Applicant's independent claim 18 recites limitations similar to previously discussed claims 1, 8 and 11, and since Siaperas is only cited to teach a discreet carabineer clip, Sawinski, Charlier and Siaperas, alone or in any combination, fail to teach or suggest the limitations present in Applicant's claims discussed above with respect to the §103 rejection based on Sawinski and Charlier. For example, none of the cited references of record teach or suggest *a portable housing at least a portion of which is formed as a carabineer clip or a flash memory disposed in the housing as recited in Applicant's claim 18*. Since claims 4, 17, 19 and 21-22 respectively depend from Applicant's independent claims 1, 11 or 18, *prima facie* obviousness has not been established with respect to any of Applicant's claims. For the foregoing reasons, Applicant respectfully requests reconsideration and withdrawal of the §103 rejection based on Sawinski, Charlier and Siaperas.

CONCLUSION.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,


Stuart A. Whittington
Registration No. 45,215
(480) 203-3235

7037 E. Monte Circle
Mesa AZ. 85209

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